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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,877	06/25/2003	Fred R. Wolf	P08096US00 - PHI 1437	5242

27142 7590 01/06/2009

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EXAMINER	
AHMED, HASAN SYED	

ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
01/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/606,877	WOLF ET AL.	
	Examiner	Art Unit	
	HASAN S. AHMED	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *20 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,12-16,20,21 and 27-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,12-16,20,21 and 27-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/13/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of applicants' supplemental amendment, filed on 20 October 2008 and IDS, filed on 13 November 2008.

* * * * *

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 12-16, 20, 21, and 27-29 remain rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2003/0154513 ("Eenennaam").

Eenennaam discloses methods for the production of transgenic plants (*see* abstract) comprising:

- the mixed tocotrienols of instant claim 1 (*see* paragraph 0222);
- the ruminant of claim 12 (*see* paragraph 0283);
- the genetically modified grain cereal crop of instant claims 14 and 27 (*see* paragraphs 0160, 0233, 0313, examples 1, 3, 4, and claim 8);
- the corn of instant claim 15 and 28 (*see* paragraphs 0160, 0233, 0313, examples 1, 3, 4, and claim 8); and
- the oil of instant claims 16 and 29 (see paragraph 0042).

The cattle of instant claim 13 is anticipated by the ruminant disclosed by Eenennaam at paragraph 0238.

The improved tissue quality of instant claims 1 and 20 and oxidative stability of instant claims 2 and 21 are inherent features of tocotrienols (*see* U.S. Application No. 2002/0108148, paragraph 0005).

The at least 150 ppm mixed tocotrienol concentration of instant claims 1 and 4 and 50 ppm to 500 ppm tocotrienol concentration range of instant claims 20, 27 and 29 are an inherent feature of corn oil (*see* U.S. Application No. 2002/0151733, table 3).

* * * * *

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 2, 12, 13, 14-16, 20, 21, and 27-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 11/153,463 ('463). Although the conflicting claims are not identical, they are not patentably distinct from each other because '463 claims a method of improving the tissue quality of an animal, including ruminant animals, using mixed tocotrienols. *See* claims 1, 12, and 19.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*

2. Claims 1, 2, 12, 13, 14-16, 20, 21, and 27-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/530,075 ('075). Although the conflicting claims are not identical, they are not patentably distinct from each other because '075 claims a method of improving the tissue quality of an animal, including ruminant animals, using mixed tocotrienols. *See* claims 1, 10, and 13.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

* * * * *

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Lanari, M. C., et al., *Effect of Dietary tocopherols and tocotrienols on the antioxidant status and lipid stability of chicken*, MEAT SCIENCE, vol. 68, pages 155-162 (2004).

- Kang, Kyung R, et al., *Tocopherols, retinol and carotenes in chicken egg and tissues as influenced by dietary palm oil*, JOURNAL OF FOOD SCIENCE, vol. 63, no. 4, pages 592-596 (1998).
- U.S. Patent Nos. 6,610,867; 6,740,508; and 5,821,264.

* * * * *

Response to Arguments

Applicants' arguments filed on 13 June 2008 have been fully considered but they are not persuasive.

35 USC 102

1. Applicants argue that Eenennaam does not anticipate the limitation "mixed tocotrienols" as defined in the instant specification (*see* remarks, paragraph bridging pages 4 and 5).

Examiner respectfully disagrees. Eenennaam discloses elevated levels of α, γ, δ, and β-tocotrienols (*see* paragraph 0222).

2. Applicants argue that Eenennaam does not disclose feeding an animal mixed tocotrienols (*see* remarks, page 5).

Examiner respectfully disagrees. Eenennaam states, "[a]ny of the plants or parts thereof of the present invention may be processed to produce a feed, meal, protein, or oil preparation." *See* paragraph 0283. As explained above, the plants of Eenennaam have been genetically modified to produce elevated levels of α, γ, δ, and β-tocotrienols (*see* paragraph 0222).

3. Applicants argue that, "Eenennaam et al. does not present any evidence or data that the transgenic plants disclosed therein contain elevated levels of mixed tocotrienols." *See* remarks, page 5.

The Eenennaam et al. reference explicitly claims transgenic plants with elevated levels of tocotrienol (*see* claims 21, 31, 55, 60, 68, 69, 73, 79, 87).

Additionally, each claim of an issued patent enjoys a presumption of validity (*see* 35 USC 282); this includes 35 USC 101, 112 (first and second paragraphs), 102, and 103. Thus, examiner respectfully submits that it may be inferred that the transgenic plants of Eenennaam et al. have elevated levels of tocotrienols.

*

Double Patenting

Regarding copending Application Nos. 11/153,463 and 11/530,075, applicants argue that the applications do not disclose or claim an animal diet using mixed tocotrienols alone. *See* remarks/arguments, pages 8-9.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). See MPEP 2111.03. Thus, examiner respectfully submits that the scope of the instant claims is commensurate with the claims of copending Application Nos. 11/153,463 and 11/530,075.

* * * * *

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1615

/Humera N. Sheikh/
Primary Examiner, Art Unit 1615